

Remarks:

The above amendments and these remarks are responsive to the final Office action dated March 8, 2006.

Prior to entry of this Amendment, claims 15-20, 22-29, 31-33 and 35-50 remained pending in the application. In the Office action, Claims 15, 17-20, 22-25, 27-29, 31-33, 35-42 and 44-49 were rejected under 35 U.S.C. §102(a) based on Nakagiri. Claims 16, 19, 26, 43 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakagiri, and in view of Itoh et al.

Claims 15, 27-29, 31 and 39 were rejected under 25 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Claims 15, 27-29 and 39 were rejected under U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants respectfully traverse the rejections, and assert that the rejected claims are definite, are supported in the description and are not anticipated or obvious in view of the cited art.

Nevertheless, to expedite prosecution of the present application to issuance of a patent and to more particularly point out selected aspects of the claims, applicants have cancelled claims 31-33. Applicants reserve the right to pursue any of the canceled claims in their original forms at a later time.

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Furthermore applicants have presented arguments showing that claims 15-20, 22-29, 31-33 and 35-50 are definite, are supported in the description and are not anticipated or obvious in view of the cited art. Accordingly, in view of the foregoing arguments and the following remarks, applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Rejections under 35 USC § 102(e)

As indicated above, claims 15-20, 22-29, 31-33 and 35-50 were rejected under 35 U.S.C. §102(e) based on Nakagiri. As noted above, by this amendment, applicants have cancelled claims 31-33. Claims 15, 17-20, 22-25, 27-29, 35-42 and 44-49 thus remain rejected under 35 U.S.C. §102(e) based on Nakagiri, and are addressed below.

Nakagiri discloses an information processing apparatus including a host computer and a peripheral device. As described by Nakagiri, the peripheral device employs an identifying unit configured to identify the operating system (OS) of the host computer, and a controller to load a device driver onto the host computer based on the identified OS.

Claim 15 and other independent claims were rejected on the grounds that Nakagiri discloses download of software in response to establishment of a communication link. The applicants interpret Nakagiri's disclosure in a significantly different manner and respectfully disagree with the Examiner.

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Independent claim 15 reads:

15. A method for use in enabling printing on a printing device, the method comprising:

detecting the establishment of a communication link between a computing device and the printing device where establishment of the link includes transmission of computing device parameters to the printing device; and

in response to the establishment of the communication link, downloading print software stored in memory of the printing device to the computing device, the print software being useful in the computing device printing documents on the printing device.

A. Establishment of a communication link.

Claim 15 recites "establishment of a communication link."

Nakagiri only describes wired connections where communications links are established on installation. The words "establish", "link" and "connection" are not used by Nakagiri at all. Nakagiri never discloses the step of making a communication link from a computer to the printer or between any devices.

A wireless communication link is fundamentally different than a wired link. A wireless communication link is often a direct link between two previously unaffiliated units that must use handshake protocols to establish compatibility. In contrast, wired connections typically have compatibility determined by component selection.

B. Downloading print driver in response to the communication link.

Claim 15 recites "in response to the establishment of the communication link, downloading print software." Nakagiri downloads software only in response to commands and requests from a host computer where communication was previously established.

Each independent claim by Nakagiri describes a command sent by a requesting computer and a device driver sent by the printer **in response to the command**. An

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example is claim 6 which states in part: "...sending a command to an external apparatus... for requesting the external apparatus to transmit the device driver..." and "...receiving the device driver transmitted...**In response to the command...**"

Claim 6 and other independent claims of Nakagiri have an additional step that has to occur after communication is established with the printer and preceding sending the request command. The requesting computer, having previously identified the printer type, is "...judging whether a device driver for controlling the device exists in memory..."

In Fig. 3 step S34, the printer tests for a "Printer Driver Transmission Command" from the host computer. The printer then transmits the printer driver, **In response to this command.**

In Fig. 6 step S64 is "Transmit Printer Driver Transmission Command." The printer then transmits the printer driver **In response to the transmission command.**

Clearly, Nakagiri is not transmitting device drivers in response to the establishment of a communication link. Nakagiri, by his own words, is transmitting the device driver **in response to a request command.**

For at least the foregoing reasons, claim 15 is not anticipated by Nakagiri, and the rejection of claim 15 under 35 U.S.C. §102(e) based on Nakagiri must be withdrawn. Claims 17, 18, 20 and 22-25 depend from claim 15, and thus are distinguished for at least the same reasons as claim 15. Independent claims 27-29, 31 and 39 and their dependent claims use similar or identical language to claim 15, and thus are distinguished for at least the same reasons as claim 15. The rejection of claims 17-20,

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22-25, 27-29, 35-42 and 44-49 under 35 U.S.C. §102(e) based on Nakagiri thus also must be withdrawn.

Rejections under 35 USC § 103

As noted above, claims 16, 19, 26, 43 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakagiri, and in view of Itoh et al.

As noted above, Nakagiri does not describe establishing a communication link and does not describe downloading software upon establishing a link. Itoh et al. does not correct this defect. Accordingly, claims 16, 19, 26, 43 and 50 are allowable for at least the same reasons as set forth above with respect to claim 15.

Rejections under 35 USC § 112 first paragraph

As indicated above, claims 15, 27-29, 31 and 39 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner was unable to locate a portion of the original filed specification that teaches "detecting the establishment of a communication link between a computing device and the printing device where establishment of the link includes transmission of computer device parameters to the printing device" as cited in the claims. As previously noted, claim 31 has been cancelled.

The application states, in paragraphs 6 and 7:

"The printing device is typically configured to download the print software to the computing device upon establishment of the communication link between the printing and computing device.

The method typically includes detecting the establishment of a communication link between a computing device and a printing device."

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In paragraph 19 the application states:

"Printing device 12 is typically configured to identify and to select print software that is compatible with computing device 14. This may be accomplished by computing device 14 sending certain compatibility information over communication link 28."

These passages from the specification clearly disclose the claimed subject matter in a manner sufficient to meet the written description requirement.

Claims 15, 27-29 and 39 clearly comply with the written description requirement as the specification clearly contains a written description of the invention and of the manner and process of making and using it. Accordingly, claims 15, 27-29 and 39 comply with the written description requirement and are allowable.

Rejections under 35 USC § 112 second paragraph

As indicated above, claims 15, 27-29 and 39 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner indicates that "where establishment of the link includes transmission of computer device parameters to the printing device," is unclear. The Examiner is unsure as to whether "computer device parameters", as cited, are parameters that are used to establish communication link between printer and computer device, or parameters that are used to determine an appropriate and/or compatible print software for computing device.

The specification on page 6, lines 4-7 states "[p]rinting device 12 is typically configured to identify and to select print software that is compatible with computing device 14." Furthermore, it is noted that "[t]his may be accomplished by computing

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device 14 sending certain compatibility information over communication link 28." This does not preclude the possibility that compatibility information or "computer device parameters" will be used to establish a communication link between printer and computer device as well.

The specification clearly details and supports the claim language. It is not clear to the applicants why this distinction of the use of the "computer device parameters" is germane in this case.

The Examiner also states "as clearly stated on page 6, lines 5-15, 'computer device parameters' are transmitted after the communication between printer and computer device have been established."

With all due respect, the applicants are unclear how the Examiner arrived at this conclusion. Lines 5-15 provide examples of possible computer device parameters and how they may be used. Nowhere does it state that 'computer device parameters' are transmitted after the communication between printer and computer device have been established."

Again, the claims as they are stated are definite and particularly point out and distinctly claim the subject matter which applicants regard as the invention. Accordingly, claims 15, 27-29 and 39 comply with the written description requirement and are allowable.

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Conclusion

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Walter W. Kamstein
Registration No. 35,565
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicants

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner T. Pham, Group Art Unit 2624, Assistant Commissioner for Patents, at facsimile number (571) 273-8300 on May 8, 2006.



Christie A. Doolittle

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